

## **REMARKS**

Applicants appreciate the consideration of the present application afforded by the Examiner. Claims 1-11 were pending prior to the Office Action. Claims 12-21 have been added through this Reply. Therefore, claims 1-21 are pending. Claims 1, 8, 12, and 19 are independent. Favorable reconsideration and allowance of the present application are respectfully requested in view of the following remarks.

### ***Note***

For convenience and clarity, all citations to the instant specification hereinafter refer to the paragraph numbers found in the pre-grant publication of this application, U.S. Pub. No. 2008/0247913 to Suovaniemi et al.

### ***35 U.S.C. § 112, 1st Paragraph Rejection***

**Claims 1-11** stand rejected under 35 U.S.C. § 112, 1<sup>st</sup> paragraph, as allegedly being based on a disclosure which is not enabling. The Examiner alleges that “[t]he motor is critical or essential to the practice of the invention,” that “[t]he specification states that the device is an electrical pipettor including a motor [sic],” and that “[i]t is unclear how the device can function without the motor” (see Office Action, page 4, item 3). Applicants respectfully disagree.

For example, paragraphs [0001] and [0002] of the instant specification refer to “manual” pipettors. Paragraph [0006] discusses certain problems encountered with “automatic dispensers” whereas subsequently paragraph [0007] recites “[i]n turn” certain problems of “hand held pipettors.” Further, paragraph [0017] discusses an embodiment for an electrical pipettor including a motor, whereas paragraph [0018] discusses a hand held mechanical pipettor embodiment. One of ordinary skill in the art would understand a hand-held mechanical pipettor to be capable of functioning based on operation supplied manually by a user, and not requiring a motor as critical or essential to the practice of the invention, as asserted by the Examiner. Further, a motor is recited in dependent claim 5, for example, but is not expressly claimed in the current independent claims.

The Examiner further asserts that “there is no disclosure of how one performs the method of claim 9 when the sample has already been received and dispensed in claim 8” (see Office

Action, page 4, second paragraph). Applicants respectfully disagree. The activation of the secondary means in claim 9 is not the same as receiving the sample or dispensing the sample as recited in claim 8, but is instead is a step to prepare the secondary means prior to receiving the sample. For example, the specification refers to “activating” the spring refers to storing the potential energy and then locking it from being released (“release the said activation”; see, e.g. [0016] of the instant specification). Through this Reply, Applicants have amended claim 9 for clarity and respectfully submit that the claimed features are indeed disclosed in the specification.

Based on the foregoing, Applicants respectfully request that the 35 U.S.C. § 112, 1<sup>st</sup> paragraph rejection of claims 1-11 be withdrawn.

**Claims 4 and 6** stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. The Examiner alleges that the limitation of “an upper flange” added in the previous amendment is not sufficiently described in the specification (see Office Action, page 4, third paragraph). Applicants respectfully disagree.

Applicants previously amended the claim language to address the Examiner allegations of indefiniteness on pages 2-3 the Office Action dated August 17, 2009, in which the Examiner objected to, *inter alia*, the limitation of “a mechanical response” in original claim 4. Although this limitation may seem to refer to an action based on the word choice, the limitation “mechanical response” is actually described in the instant specification as referring to a structural component of the device.

For example, the specification recites: “In addition the launch means comprise a spring, a magnet and activation means, which is preferably an activation pin, or similarly functioning mechanical response” (paragraph [0017], lines 9-12); and “When the movement continues upwards the launch pin comes into contact with a response which is preferably provided in the pipettor body” (paragraph [0017], lines 18-20). Additionally, reference 5 in Figure 1 is described in the specification as “an upper response 5” in paragraph [0023], which further states that “[t]he launch pin is arranged so that when it comes into contact with the upper response arranged in the pipettor body, it forces the actuator shaft apart from the magnet inside the launch means body” (paragraph [0025], lines 10-13).

Nevertheless, in the interest of further prosecution and the Examiner’s suggestion that the claim be amended to clearly define structural components (see Office Action of Aug. 17, 2009,

page 3), Applicants elected to amend the claims to recite “an upper flange.” This change is supported by at least the description in the specification and by at least Figure 1 which clearly shows a flange structure.

Based on the foregoing, Applicants respectfully request that the § 112, first paragraph, rejection of claims 4 and 6 be withdrawn, or in the alternative, that the Examiner indicate which language he would prefer.

**Claim 6** also stands rejected under 35 U.S.C. § 112, first paragraph, because the specification allegedly does not reasonably provide enablement for a device comprising multiple-channels. Applicants respectfully disagree. Multi-channel pipettors are well-known devices in the art and one of ordinary skill in the art would appreciate that the claimed invention can be adapted for use in such a multiple channel pipettor. Applicants respectfully request that the § 112, first paragraph, rejection of claim 6 be withdrawn.

#### ***35 U.S.C. § 112, 2nd Paragraph Rejection***

Claims 1-11 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Although Applicants do not necessarily agree with the Examiner’s assertion of indefiniteness, Applicants have amended the claims to address the Examiner’s concerns.

Applicants respectfully request that the §112, second paragraph, rejection of claims 1-11 be withdrawn.

#### ***Claim Rejections - 35 U.S.C. §102***

Claims 1, 2, 5, and 6 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Pat. No. 5,330,717 to Berteloot et al. (“Berteloot”). Applicants submit the Examiner has failed to establish a *prima facie* case of anticipation and traverse the rejection.

Independent claim 1 recites, *inter alia*, the features of,

*a primary means for achieving a suction movement of the suction plunger to receive a sample into the liquid dispenser at a first speed; and*

*a secondary means for achieving an emptying movement of the suction plunger to dispense the sample from the liquid dispenser at a second speed greater than the first speed,*

*wherein the primary means and secondary means are different from each other.*

Applicants respectfully submit that the Berteloot reference cannot disclose all of the elements of claim 1.

Applicants have previously asserted that Berteloot cannot anticipate claim 1 at least because piston 24 is not described as being driven to receive a sample (see Response dated November 10, 2009, pages 8-10). In response, the Examiner asserts that piston 24 of Berteloot is a structure that is capable of performing the functions of the primary and secondary means of the claimed invention and that “there is nothing precluding one from considering the knob or element on the end of the piston 24 as equivalent to a primary means” (see Office Action, pages 2-3). Applicants respectfully disagree.

Berteloot cannot disclose or suggest that the piston 24 is structurally capable of being operated to receive a sample, at least because Berteloot expressly discloses that the portion of the injector comprising the piston is used in a manner entirely different from a suction movement. Indeed, the priming of the piston in the upper part of the injector is expressly performed prior to being attached to the bottom part of the injector, where the actual pipette 18 containing the sample is disposed (see Berteloot, col. 7, lines 11-17 and col. 11, lines 28-34). It is unknown which portions of the injector would be attached or unattached during the hypothetical suction movement alleged by the Examiner, which again is not disclosed by the reference. Nor is the suction capability alleged by the Examiner inherent to the structure of the injector described in Berteloot, at least since piston 24 is driven to press on rod 20 which ejects the sample out of pipette 18 (see id., col. 3, lines 39-61). Again, it is entirely unclear which of these elements, in what combination, are capable of achieving a suction movement as claimed.

In support of his argument, the Examiner refers to knob 24 as shown in U.S. Pub. No. 2005/0142038 (the ‘038 publication) as showing a conventionally known dispenser where “a user would pull on the knob and press on the knob to perform aspiration and dispensing, respectively” (Office Action, pages 2-3). However, this reference is not comparable to the injector of Berteloot at least because Berteloot is drawn to a method of rapidly sampling predetermined volumes of a mixture in a manner entirely distinguishable from the ‘038 publication. Additionally, the ‘038 publication cannot cure deficiencies of a reference which

does not anticipate the claimed invention under 35 U.S.C. § 102(b), and the Examiner is not relying upon the ‘038 publication under § 103(a) to allegedly cure the deficiencies of Berteloot.

In response to the Examiner’s assertion that “the claim does not preclude the respective means from being the same structure” (see Office Action, page 2), Applicants note that the claim as amended recites that the primary and secondary means are different from each other.

Based on the foregoing, Applicants respectfully request that the rejection of claims 1, 2, 5, and 6 under 35 U.S.C. § 102(b) be withdrawn.

Claims 1 and 5-8 stand rejected under 35 U.S.C. § 102(b) or (e) as allegedly anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as allegedly obvious over what the Examiner argues amounts to “applicant admission and acknowledgement of the state of the prior art” (see Office Action, page 8, item 12). Applicants submit the Examiner has failed to establish a *prima facie* case of anticipation or obviousness and traverse the rejection.

The Examiner asserts that Applicants’ discussion of the state of the prior art in paragraphs [0012]-[0015] renders the claims anticipated or obvious. Applicants respectfully disagree. Although reference is made to the adjustability of the plunger movement of previous electrical pipettors, the specification expressly states that the previously-known pipettors “do not make difference between the receiving and removal phases so that the removal movement speed would be fastened to solve [the] particular problem [wherein] with small volumes during the removal phase the sample tends to revolve to the outer surface of the tip” (paragraph [0014]). Also, paragraph [0014] recites that “the previously known motors do not present such motors which could produce sufficient speeds [to solve the recognized problem].”

Indeed, Applicants have addressed this recognized problem by introducing secondary means for achieving the emptying movement of the suction plunger to dispense the sample from the liquid dispenser at a second speed greater than the first speed at which the primary means achieves the suction movement of the plunger. Additionally, the primary means and secondary means are different from each other. Nowhere in the instant application do Applicants admit that the prior art discloses such secondary means.

Accordingly, Applicants respectfully request that the rejection of claims 1 and 5-8 under 35 U.S.C. § 102(b) or (e) or § 103(a) be withdrawn.

Claims 1, 2, and 5-10 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Pub. No. 2005/0214172 to Burgisser (“Burgisser”). Applicants submit the Examiner has failed to establish a *prima facie* case of anticipation and traverse the rejection.

The national stage filing date of the instant application under § 371 is April 11, 2006. The Burgisser reference has a publication date of September 29, 2005. Therefore, Burgisser does not qualify as prior art under § 102(b) because it is not a reference published more than one year prior to the U.S. filing date of the instant application. Accordingly, Applicants respectfully request that the rejection of claims 1, 2, and 5-10 under 35 U.S.C. § 102(b) be withdrawn.

However, to expedite prosecution Applicants offer the following comments regarding the Burgisser reference:

Burgisser discloses a method and device for dosing small volumes of liquid in which a motor is driven at high acceleration to discharge from a syringe a two part volume consisting of a gas volume and a liquid volume (see Burgisser, paragraph [0009] as cited by the Examiner).

However, Burgisser fails to disclose the primary means and secondary means of independent claims 1 and 8. More specifically, Burgisser fails to disclose or suggest “*a primary means for achieving a suction movement of the suction plunger to receive a sample into the liquid dispenser at a first speed; and a secondary means for achieving an emptying movement of the suction plunger to dispense the sample from the liquid dispenser at a second speed greater than the first speed, wherein the primary means and secondary means are different from each other*” (emphasis added). Instead, Burgisser discloses both of the actions of drawing in the volume and dispensing the volume are achieved by the same means, i.e., the syringe plunger 6 as driven by motor 1 (see *id.*, Figure 1). Accordingly, Burgisser does not anticipate all of the features of independent claims 1 and 8.

#### ***Claim Rejections - 35 U.S.C. §103(a)***

Claims 3 and 4 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Berteloot in view of U.S. Pat. No. 6,352,673 to Rainin et al. (“Rainin”). Claims 3, 4, and 11 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Burgisser in view

of Berteloot and Rainin. Applicants submit the Examiner has failed to establish a *prima facie* case of obviousness and traverse the rejections.

As discussed above, Berteloot fails to disclose or suggest all of the features of independent claim 1; claims 1 and 5-8 are not anticipated or obvious over Applicants description of the prior art in the specification; and the § 102(b) rejection of independent claims 1 and 8 is defective since Burgisser fails to qualify as prior art under § 102(b). Moreover, Applicants have addressed the Examiner's rejections of claim 1 under § 112, 1<sup>st</sup> and 2<sup>nd</sup> paragraphs. Therefore, Applicants submit that no sustainable rejection of independent claims 1 and 8 is currently made. Accordingly, independent claims 1 and 8 are in condition for allowance. Dependent claims 3, 4, and 11 are likewise in condition for allowance at least due to their dependency from claims 1 and 8, directly or indirectly.

Accordingly, Applicants respectfully request that the rejections of claim 3, 4, and 11 under 35 U.S.C. § 103(a) be withdrawn.

#### *New Claims*

New claims 12-21 have been added through this Amendment, and are considered to be in condition for allowance. No new matter has been entered.

### CONCLUSION

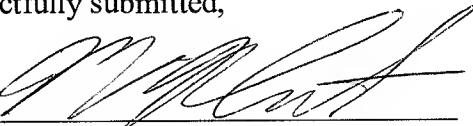
All objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance. Notice of same is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John R. Sanders (Reg. No. 60,166) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

By 

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